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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/689,592	10/13/2000	Hiroiyuki Tanimura	2185-0475P	8209

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06/09/2003

Birch Stewart Kolasch & Birch LLP
PO Box 747
Falls Church, VA 22040-0747

EXAMINER

REDDICK, MARIE L

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 06/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-11

Office Action Summary	Application No.	Applicant(s)	
	09/689,592	TANIMURA ET AL.	
	Examiner	Art Unit	
	Judy M. Reddick	1713.	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 5-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of the Group I invention in Paper No. 10(03/25/03) is acknowledged. The traversal is on the ground(s) that no undue burden would be placed upon the Examiner to consider the patentability of each of claims 1-8. This is not found persuasive because an unduly and burdensome search is required, contrary to the opinion of Counsel. Note further that the search required for the Groups II and III invention is not required for the Group I invention. Moreover, Counsel has failed to point out wherein the reasons advanced by the Examiner to establish distinctness between the inventions, as claimed and grouped or the evidence for separate status, classification and/or search are in error. Accordingly, claims 5-8 remain withdrawn from consideration by the Examiner.

The requirement is still deemed proper and is therefore made FINAL.

2. This application contains claims 5-8 drawn to an invention nonelected with traverse in Paper No. 10. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4 are rejected under 35 U.S.C. 102(b or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over *Otawa et al* (U.S. 4,818,785) or *Yamazaki et al* (U.S. 6,183,866).

Each of *Otawa et al* and *Yamazaki et al* discloses polyolefin-based resin compositions and processes of producing said polyolefin resin-based compositions wherein said processes involve, basically, melt kneading a polyolefin-based resin and fine polymer particles containing a volatile component. Each of patentees therefore anticipate the instantly claimed invention with the understanding that the components of each of patentees overlaps in scope with the claimed compositional components, in both content and character. See, e.g., the Abstract, cols. 3-13 and the Runs of *Otawa et al* and the Abstract, the Runs and claim 11 of *Yamazaki et al*. More specifically, *Otawa et al* teach thermoplastic elastomer compositions defined basically as containing a fine particulate crosslinked amorphous copolymer(A) and a crystalline olefin resin(B) in a weight ratio of 90:10 to 1:99 wherein the fine particulate crosslinked amorphous copolymer derived from at least ethylene and an alpha-olefin(corresponding to the polymer fine particles per the claimed invention) has an average particle diameter of 0.2 to 50 μm and contains at least 15 % by weight of toluene insolubles formed in the particles(col. 3, lines 1-68, col. 4, lines 1 and 2 and col. 5, lines 45-65). Further, @ the paragraph bridging cols. 4 and 5, *Otawa et al* teach that the amorphous copolymer is prepared using, in the medium, aliphatic hydrocarbons, alicyclic hydrocarbons, aromatic hydrocarbons, etc. and that the crosslinked latex composition may further contain known compounding agents such as antiseptic agents,

surfactants, pH controllers, in a conventional amount(col. 14, lines 62-68). More specifically, *Otawa et al* exemplify a solution of the amorphous copolymer in *n*-hexane(Run 1) which clearly meets the polymer fine particles containing 0.10 to 90 % by weight of volatile component. *Yamazaki et al* teach the use of 0.01 to 50 parts of fine particles governed by average particle sizes of from 1.4 to 1.6 μm for modifying a polyolefin. More specifically, *Yamazaki et al* in Run 1, e.g., teach adding fine core-shell particles to 100 parts by weight of polypropylene wherein, the fine particles were prepared via conducting the polymerization in the presence of 52 parts by weight of methanol. At least Run 1 of *Otawa et al* and of *Yamazaki et al* anticipate the instantly claimed invention.

While patentees are silent relative to the use of the disclosed "polymer fine particles" as "an antiblocking agent", the discovery of a new property or use for a previously known compound cannot impart patentability to the claims to that compound, even if the property or use is unobvious from the prior art(In re Schoenwald, 22 USPQ 1671).

Response to Arguments

6. Applicant's arguments filed 03/25/03 have been fully considered but they are not persuasive.

Relative to *Otawa et al* or *Yamazaki et al*—The crux of Counsel's arguments appears to hinge on a) neither of patentees disclosing or suggesting polymer fine particles containing 0.10 to 90 % by weight of a volatile component and b) neither of patentees recognizing that a good dispersion of polymer fine particles can be achieved by the use of such polymer fine particles.

Relative to a)— Counsel has not shown that the fine polymer particles of the Runs, viz. Run 1 of each of patentees do not possess the claimed volatile component content. Mere attorney's arguments, unsupported by factual evidence, are given little weight(In re Lindner, 173 USPQ 356).

Relative to b)—The discovery of a new property or use for a previously known compound cannot impart patentability to claims to that compound, even if the property or use is unobvious from the prior art (In re Schoenwald, 22 USPQ 1671).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

J. M. Reddick
Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR *JMR*
June 4, 2003

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-4, drawn to a process for producing a polyolefin-based resin composition, classified in class 524, subclass 80.
 - II. Claims 5 and 6, drawn to a process for producing a polyolefin-based resin film, classified in class 264, subclass 210.1.
 - III. Claims 7 and 8, drawn to resin film, classified in class 428, subclass 500.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as it could be used in an injection molding process. See MPEP § 806.05(d).
3. Inventions I and III are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a composition that could be used to make injection molded products and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably

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distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. Inventions II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process, for example, polyolefin-based resin composition could be injection molded into a flat sheet-like piece, then stretched to orient and shape the piece into a film. It is noted that claims 7 and 8 are product by process claims and that in product by process type claims only the physical characteristics of the formed product are considered patentable relevant to the claim.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with John W. Bailey on 8-30-02 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-4. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 5-8 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey P. Shipsides whose telephone number is 703-306-0311. The examiner can normally be reached on Monday - Friday 9 AM till 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan H Silbaugh can be reached on 703-308-3829. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Geoffrey P. Shipsides
Examiner
Art Unit 1732

Geoffrey P. Shipsides/gps
September 8, 2002